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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,357	09/07/2000	Kenneth P. Weiss	W0537/7005	1625

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EXAMINER	
FLANDERS, ANDREW C	

ART UNIT	PAPER NUMBER
2615	

MAIL DATE	DELIVERY MODE
03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/657,357	WEISS, KENNETH P.	
	Examiner	Art Unit	
	Andrew C. Flanders	2615	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: 5.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-4,6-18,28-30 and 36-39.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Remarks.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 16 February 2006 have been fully considered but they are not persuasive.

Applicant alleges:

> Thomason discloses that a viewer watching a historical program (i.e., watching a program being supplied from the memory) can "catch up" with the live broadcast by accelerating the playback. However, nowhere does Thomason disclose or suggest that once that viewer has "caught up," the device is automatically returned to a mode in which the program is no longer supplied via the memory. Rather, as noted in the Examiner's interview summary, Thomason is silent as to what happens when playback does actually catch up to the live incoming signal (i.e., when the time delay is eliminated). The Examiner contends that it is obvious or implicit in Thomason that the device will switch back to the "live" path after catching up. Applicant respectfully disagrees.

Examiner respectfully disagrees. Thomason discloses that the user can catch up to live programming. The fact that live programming is achieved shows that the device is returned to normal mode (i.e. live mode). This is an obvious feature as taught on pages 8 and 9 of the final office action. Thomason shows in col. 2 lines 18 – 27 that a user can catch up to a live program. Whitby teaches the two modes as acknowledged by Applicant. Put simply, Whitby discloses two modes, a normal mode and a replay mode. Thomsaon discloses catching up with 'live mode'. When the teachings of Thomason are applied to Whitby, Whitby will return to live mode when it is caught up, thus reading on the limitation of 'automatically returning to normal mode.'. Thus since

the device returns to 'live' mode when it catches up, the combination makes obvious the limitation of 'automatically returning the device to normal mode.'

The arguments regarding inherency are not persuasive as the rejection in the final office action was not based on inherency, but rather obviousness. The implicit statement in the interview summary was merely to show that the Examiner believes the limitation to be extremely obvious in the combination.

Applicant further alleges:

> Applicant further asserts that the recitation of claim 1 is also not an obvious extension or modification of Thomason. As discussed above, having the recorder remain and in record and playback mode after catching up to the live broadcast (i.e., the signal is played through the buffered path but with no substantial delay), is a perfectly reasonable and workable manner in which Thomason's system could operate. Thus, there is no reason or motivation suggested by the references to modify the combination of Whitby and Thomason so as to include automatic return to normal mode. The law is clear that in order to combine and/or modify the teachings of prior art references, there must be a clear and definite suggestion or motivation present in the prior art (not in Applicant's disclosure or claims) to make the modification and/or combination. This motivation or suggestion is lacking in the present case due to the facts that Thomason contains no express discussion of what happens when the playback catches up to the live signal, and Thomason discloses that the system can continue to work without being automatically retuned to normal mode.

Examiner respectfully disagrees. As shown above, Whitby discloses two modes, a normal mode and a replay mode. Thomsaon discloses catching up with 'live mode'. When the teachings of Thomason are applied to Whitby, Whitby will return to live mode when it is caught up, thus reading on the limitation of 'automatically returning to normal

mode.' As to the allegations that the motivation or suggestion to combine is not present in the prior art, page 9 of the final office action states clearly that "One would have been motivated to [combine] in order to be able to start a program on the Whitby device well after it started, to maintain continuity after interruption, and have the ability to replay, or playback in slow motion" which is clearly shown in Thomason col. 1 liens 1 – 67 and col. 2 lines 1 – 51.

Applicant further alleges:

> The proposed combination of Whitby and Thomason neither discloses automatic switching between replay and normal modes when the radio station is changed, nor is this feature inherent or "implicit" in the references. Thomason is directed to a television recorder and therefore does not discuss what may happen when a radio station is changed. However, Thomason discussed recording different television channels and does not disclose or suggest that the device is automatically returned from replay mode to normal mode with incoming inputs applied to the television when there is a channel change on the television. Whitby discloses a radio device and discusses changing the radio station, but also does not disclose or suggest automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio, as is recited in Applicant's claim 28. As was the case above where Thomason (or the combination of whitby and Thomason) could continue to function when playback "caught up" with the live broadcast without automatically changing the mode of the device (i.e., the signal is simply played through the buffered path with no substantial delay), here too, the device of Whitby and Thomason could also continue to function in the recording/playback mode when the radio station (or TV channel) is changed. The device would simply continue to record and playback the signal now being received from a different channel/station. As discussed in Applicant's previous response, Whitby similarly discloses that when the device is in playback mode, it continues to record (see e.g., page 10, line 12 to page 11, line 18) and thus, it would be perfectly logical to have the device remain in playback mode when the station is changed on the radio. Thus, the recitation in Applicant's claim 28, namely, "said radio is automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station

> change on the radio," is not inherent or implicit in the references because it is not necessary, as required to satisfy the test for inherency discussed above.

Examiner respectfully disagrees. Applicant states that "it would be perfectly logical to have the device remain in playback mode when the station is changed." Examiner submits that this would not be perfectly logical. In fact, if this were the case, it would completely defeat the purpose of the device having a live path and a record path. It may be desirable in some configurations to operate in the manner construed by Applicant, however that is not the only way and it is not the most desirable way in every situation. Further, the rejection was based upon an obvious combination, not an inherency argument. The implicit statement in the rejection was merely to show that the Examiner believes the limitation to be extremely obvious in the combination (the obvious statement immediately precedes it).

Applicant further alleges:

> Furthermore, this limitation is not an obvious modification of the references. There is nothing in Whitby that discloses or suggests that if the device is a replay mode (i.e., is storing and delayedly playing out audio) that changing the radio station will cause the device to change into a different mode. Simiarly, as discussed above, Thomason also contains no mention or suggestion of this feature. The law is clear that the prior art must contain a definite teaching, suggestion or motivation that would lead one of ordinary skill in the art to either combine to references or modify a reference (or combination of references). This required teaching, suggestion or motivation is completely lacking in the instant case. Although Whitby discloses that a user can tune the radio to change the station (page 5, lines 14-15), Whitby does not link the station change to a change in the mode of the device. This feature is also not shown in Thomason or any other reference of record, whether taken alone or in combination with Whitby. Furthermore, because the device can continue

to operate without being automatically returned to normal mode, there is no reason or motivation to modify it.

Examiner respectfully disagrees. As to the allegations that the motivation or suggestion to combine is not present in the prior art, page 9 of the final office action states clearly that "One would have been motivated to [combine] in order to be able to start a program on the Whitby device well after it started, to maintain continuity after interruption, and have the ability to replay, or playback in slow motion" which is clearly shown in Thomason col. 1 liens 1 – 67 and col. 2 lines 1 – 51.

SINH TRAN
SUPERVISORY PATENT EXAMINER